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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/554,481

10/24/2005

Diane M. Artman

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11/28/2008

THE LUBRIZOL CORPORATION
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EXAMINER

OLADAPO, TAIWO

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

11/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/554,481	Applicant(s) ARTMAN ET AL.	
	Examiner TAIWO OLADAPO	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/13/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The applicant's amendment and response dated 8/13/2008 has been fully considered and entered for the record. The applicant's amendment/argument does not overcome previous rejections, which are hereby maintained. New rejections are made to reject new claims.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 17 – 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Calder (US 6,846,782)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

4. In regards to claim 1, Calder teaches a lubricating oil composition comprising low sulfur of below 1% (column 2 lines 47 – 49), low phosphorus of i.e. 0.03 to 0.05% (column 2 lines 50 -

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51), lubricating oil (column 2 lines 20 – 25), sulfurized olefins, 1.8 % dispersant and sulfated ash content of from 0.8 or 1.2 (column 13 – 14, Tables I & II) all of which meet the claimed ranges.

Claim Rejections – 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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6. Claims 1 – 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fetterman, Jr. et al. (US 5,102,566) in view of Davis (US 4,582,618)

7. The previous rejections of claims 1 – 16 are maintained and hereby incorporated by reference, herein. See §5 – 21 of the previous office action.

9. Claims 11, 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fetterman, Jr. et al. (US 5,102,566) in view of Davis (US 4,582,618) and further in view of Abraham et al. (US 2002/0006878)

10. In regards to claims 11, 20, Fetterman and Davis combined teach the composition but do not particularly teach hindered ester-substituted phenol used as an antioxidant such as represented by the compound recited in claim 20. Abraham teaches lubricant compositions useful for lubricating compression-ignited engines similar to Fetterman and Davis combined [0016]. Davis teaches that the lubricant can contain ester-substituted hindered phenol antioxidants which anticipates the structure recited in claim 20 [title, 0011].

11. It would have been obvious to one of ordinary skill in the art at the time of the invention to add the antioxidants taught by Abraham to the combined invention of Fetterman and Davis, as Abraham teaches that the antioxidants are suitable for use in compression ignited (Diesel) engines.

Response to Arguments

12 Applicant's arguments filed 8/13/08 have been fully considered but they are not persuasive.

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The applicant primarily argues that the reference of Fetterman does not teach the nitrogen-free sulfurized olefin antiwear agent of the present invention and therefore does not meet the sulfated ash and phosphorus limitation of the claim. The applicant asserts that the antioxidant compounds according to Fetterman are not sulfurized olefin but sulfurized alkyl phenols. Contrary to the argument, Fetterman teaches that the antioxidants or component B of the invention are i.e. sulfurized olefins (column 32 lines 52 – 55). Fetterman's teaching of sulfurized alkyl phenols identifies other compound that can be used for component B, but do not limit the antioxidants to them alone as sulfurized olefins are also taught as being useful.

The applicant suggests that the amount of phosphorus in the oil appears to be greater than the maximum of 0.1% but cannot say so with any certainty, making the argument moot.

The applicant also argues that the amount of sulfated ash of from 0.6 to 1.2% present in the composition is not taught by Fetterman. Contrarily, Fetterman teaches that the sulfated ash level of the composition is less than about 0.6%, overlapping the claimed range (column 5 lines 34 – 35).

Therefore, since the combined references of Fetterman, Davis and Schenck teach overlapping limitations of the instant invention, they are obvious over the claimed invention and the arguments tendered do not overcome the previous rejections, which are thus maintained.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAIWO OLADAPO whose telephone number is (571)270-3723. The examiner can normally be reached on 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571)272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TO

/Glenn A Caldarola/
Acting SPE of Art Unit 1797